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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,092	11/09/2001	Michael L. White	4979US (01-01-084-02)	3991

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Marshall Gerstein & Borun  
6300 Sears Tower  
233 South Wacker  
Chicago, IL 60606-6402

EXAMINER

RADA, ALEX P

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 11/21/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/036,092

Applicant(s)

WHITE ET AL.

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 38-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51 and 52 is/are allowed.
- 6) ☒ Claim(s) 38-50 and 53-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

In response to the amendment filed August 27, 2003 in which the applicant has canceled claims 1-37, adds new claims 38-65, and claims 38-65 are pending in this office action.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 38-44, 47-48, 53-59, and 62-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Parker GP `295.

3. Arnold discloses a gaming machine having a housing (figure 1), a display unit generating video images and associated with the housing, an input device, a controller (within game machine in figure 1), placing a wager, generating on the display unit a slot game and a plurality of symbols (figure 1), allowing the user to select a first symbol from any of the plurality of symbols and a second symbol from any of the plurality of symbols using the input device, allowing the user to interchange the position of the first symbol with the position of the second symbol to define a second arrangement of plurality of symbols and determine a value payout associated with an outcome of the slot game based on the second arrangement as recited in claims 38 and 53; the first arrangement having a plurality of paylines (pg. 1 of the specification lines 96-103) as recited in claims 39 and 54; the controller is programmed to activate a first

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number of paylines of the plurality of paylines as recited in claims 40 and 55; the controller is programmed to activate additional pay lines of the plurality of pay lines responsive to a wager placed as recited in claims 41 and 56; the controller is programmed to allow the user to at least temporarily remove the first symbol from the first arrangement and to move the second symbol into a position vacated by the first symbol, in which the examiner interprets to be the overlapping of symbols to equivalent to the temporarily removal and replacement by another (pg. 2, lines 46-55) as recited in claims 42-43 and 57-58; the programmed to cause visually perceptible movement of the first symbol and the second symbol within the first arrangement in response to the interchange of the position of the first symbol and the position of the second symbol (figures 2-5) as recited in claims 44 and 59; the controller is programmed to allow the user to interchange the position of the first symbol with the position of the second symbol responsive to at least one preselected symbol, in which the examiner interprets the highlight of certain symbols (pg. 2 lines 29-55) as recited in claims 47 and 62; the controller is program to determine another value payout associated with an outcome to the slot game base on the first arrangement (pg. 2 lines 29-55) as recited in claims 48 and 63.

4. Claims 39 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnold EP '488.

5. Arnold discloses a housing (figure 1), a display unit generating video images and associated with the housing, an input device, a controller (within game machine in figure 1), placing a wager, generating on the display unit a slot game and a plurality of symbols (figure 1), allowing the user to select a first symbol from any of the plurality of symbols and a second symbol from any of the plurality of symbols using the input device, allowing the user to

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interchange the position of the first symbol with the position of the second symbol to define a second arrangement of plurality of symbols and determine a value payout associated with an outcome of the slot game based on the second arrangement.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 45 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker GP `295 in view of Dickinson `397.

8. Parker discloses the claimed invention as discussed above except for the input device is a touch-sensitive input device disposed overlaying a portion of the display unit.

Dickinson teaches a gaming device having a touch-sensitive input device disposed overlaying a portion of the display unit. By having a touch screen, one of ordinary skill in the art would provide game players with an improved gaming machine. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Parker to include a touch-sensitive input device disposed overlaying a portion of the display unit as taught by Dickinson. To do so would enhance the versatility and usefulness of any gaming machine.

9. Claims 46 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker GP `295 in view of Bansemer `165.

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10. Parker discloses the claimed invention as discussed above except for the controller is programmed to permit the interchange of the position of the first symbol and the position of the second symbol only during a limited time.

Bansemmer teaches a limited time upon which the user may operate during certain periods of the game (paragraph 49). By having time limits during a game, one of ordinary skill in the art would provide game players with an opportunity at a successful outcome. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Parker to include a time limit during certain bonus period of a game as taught by Bansemmer. To do so would provide game players an opportunity at a successful outcome.

11. Claims 49-50 and 64-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker GP '295 in view of Wiltshire '602.

12. Parker discloses the claimed invention as discussed above except for the controller is located remotely to the housing and is operatively connected to the display unit and the input device via telecommunication network as recited in claims 49 and 64; the telecommunication network is the Internet as recited in claims 50 and 65.

Wiltshire teaches operating a gaming machine remotely through a telecommunication network like the Internet. By having operating a gaming machine remotely through a telecommunication network, one of ordinary skill in the art would provide game players to participate in a gaming machine within the comforts of your own home. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Parker to include operating a gaming machine remotely through a

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telecommunication network like the Internet as taught by Wiltshire. To do so would provide all the enjoyment of playing game machine within the comforts of your own home.

*Allowable Subject Matter*

13. Claims 51 and 52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

14. Applicant's arguments with respect to claims 38-65 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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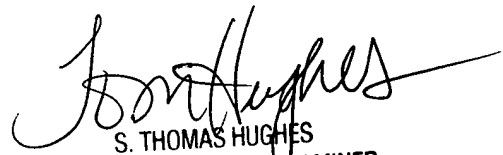
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

for  
apr

  
S. THOMAS HUGHES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700